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EXAMINER

DOAN, DUYEN MY

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,941

Applicant(s)

HENDRIKS ET AL.

Examiner

Duyen M Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detail Action

Claims 1-55 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 17-18, 19-30, 35, 36-47, 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al (us 2002/0143994) (hereinafter Sun) in view of Becker et al (us 2002/0130904) (hereinafter Becker).

As regarding claim 1, Sun disclosed establishing a connection to a messaging service adapted to provide users with a recording comprising one or messages for viewing (pg.3-4, paragraph 29); inputting handwritten stroke information message objects into a message anywhere within the recording to thereby annotate said message (pg.3-4, paragraph 29). Sun does not expressly disclose messaging service distributing said annotate message in said recording to other users

Becker taught messaging service distributing said annotate message in said recording to other users (pg.1, paragraph 8, pg.2, paragraph 13, pg.3, paragraph 35, also see figure 1, the instant messaging user interface to enter text and image into the instant messaging system and deliver to other users).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Becker with Sun's method to have messaging service distributing said annotate message in said recording to other users for the purpose providing electronic white board which allows the user to draw images and type notes to share with others (see Becker pg.1, paragraph 8).

As regarding claim 2, Sun-Becker disclosed message objects are IM objects; and said current message is an IM record (see Sun pg.3-4, paragraph 29).

As regarding claim 3, Sun-Becker disclosed copying a plurality of current messages from other applications (see Becker pg.2, paragraph 13, pg.3, paragraph 35). The same motivation was utilized in claim 1 applied equally well to claim 3.

As regarding claim 4, Sun-Becker disclosed messaging service is of a peer-to-peer type (see Becker pg.2, paragraph 17). The same motivation was utilized in claim 1 applied equally well to claim 4.

As regarding claim 5, Sun-Becker disclosed forwarding said handwritten stroke information to at least one participant (see Sun pg.3, paragraph 25).

As regarding claim 6, Sun-Becker disclosed wherein said messaging service updates a record of all said current message for distribution to, and handwritten stroke information annotation by, users of said messaging service, said method further comprising appending said handwritten stroke information onto an existing said record (see Sun pg.3, paragraph 25).

As regarding claim 7, Sun-Becker disclosed establishing said connection is initiated by a first of a plurality of said users of said messaging service (see Sun pg.3, paragraph 25).

As regarding claim 8, Sun-Becker disclosed providing a graphical user interface for said user; and said graphical user interface including a handwritten stroke input field (see Becker pg.7, paragraph 59, Fig.1, image pad 130).

As regarding claim 9, Sun-Becker disclosed graphical user interface comprises an awareness field (see Becker pg.4, paragraph 38-39, Fig.1, pals panel 100).

As regarding claim 10, Sun-Becker disclosed graphical user interface comprises a text input field (see Becker pg.7, paragraph 59, Fig.1, text pad 136).

As regarding claim 11, Sun-Becker disclosed entering text into said text input field wherein said text is associated with said message objects for transmission to said messaging service (see Becker pg.7, paragraph 59-61).

As regarding claim 12, Sun-Becker disclosed entering handwritten stroke information into said handwritten stroke input field wherein said handwritten stroke information is associated with said message objects for transmission to said messaging service (see Becker pg.7, paragraph 59-61, user draw or write on the graphical input device).

As regarding claim 13, Sun-Becker disclosed logging and displaying a complete history of said current messages in a recording field of said graphical user interface (pg.4, paragraph 38-39, Fig.1, message history panel 120).

As regarding claim 18, Sun-Becker disclosed searching said record based on user-selected criteria (see Becker pg.6, paragraph 55).

As regarding claims 19-30 the limitations are similar to claims 1-13, therefore rejected for the same rationale as claims 1-13.

As regarding claim 35 the limitations are similar to claim 18, therefore rejected for the same rationale as claims 18.

As regarding claims 36-47 the limitations are similar to claims 1-13, therefore rejected for the same rationale as claims 1-13.

As regarding claim 52 the limitations are similar to claim 18, therefore rejected for the same rationale as claims 18.

As regarding claim 53, the limitations are similar to claim 1, limitation in claim 55 are broader than claim 1, therefore rejected for the same rationale as claim 1.

As regarding claim 54, Sun-Becker disclosed inputting said information message objects wherein said information comprises speech (see Becker pg.6, paragraph 55); annotating said information message objects wherein said annotating comprises speech (see Becker pg.6, paragraph 55).

As regarding claim 55, Sun-Becker disclosed inputting said information message objects wherein said information comprises gestures (see Becker pg.6-7, paragraph 55-60); annotating said information message objects wherein said annotating comprises gestures (see Becker pg.6-7, paragraph 55-60).

Claims 14-17, 31-34, 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun-Becker as applied to claim 1 above, and further in view of Lloyd et al us pat 6779178 (hereinafter Lloyd).

As regarding claim 14, Sun and Becker disclosed all the limitation of claim 1 above, but fail to disclose current messages contains at least one URL for providing location information of an associated said message objects in said record. Lloyd teaches one of current messages contain at least one URL for providing location information of an associated said message objects in said record (col.22, lines 34-46).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Lloyd with the method of Sun-Becker to have messages contain URL for providing information location for the purpose of when the text is displayed with a URL in the status bar, user viewing the message could go to the URL by clicking on the link (see Lloyd col.22, lines 43-46).

As regarding claim 15, Sun-Becker-Lloyd disclosed each of said plurality of users may navigate through said recording field to said associated said message objects by selecting said at least one URL whereby said associated said message objects are displayed to said user (see Lloyd col.22, lines 43-46). The same motivation was utilized in claim 14 applied equally well to claim 15.

As regarding claim 16, Sun-Becker-Lloyd disclosed annotating of said messages in said recording field by any of said plurality of users; and using said hyperlink for alerting said plurality of users of said annotation (see Lloyd col.22, lines

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43-46, HTML tag to create a link). The same motivation was utilized in claim 14, applied equally well to claim 16.

As regarding claim 17, Sun-Becker-Lloyd disclosed a) navigating to a desired said message object of said recording (see Sun pg.3, paragraph 25-27); b) selecting the desired said message to be annotated (see Sun pg.3, paragraph 25-27); and c) adding new handwritten stroke information message objects to said record (see Sun pg.3, paragraph 25-27).

As regarding claims 31-34 the limitations are similar to claims 14-17, therefore rejected for the same rationale as claims 14-17.

As regarding claims 48-51 the limitations are similar to claims 14-17, therefore rejected for the same rationale as claims 14-17.

Response to Arguments

Applicant's arguments filed July 7, 2005 have been fully considered but they are not persuasive. Applicant's arguments are addressing below.

As regarding Applicant' first argument on claim 1 "Ink data is treated as a dependent annotation tool to associate with existing message records". This feature is disclosed in Sun's invention, "The use of ink data are well known in the art, their application for fuse in an instant messaging or chat system has not been known or

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suggested". Sun's invention addressed incorporate the ink data into the chat system (see Sun pg.3, paragraph 26-27).

As regarding Applicant's second argument on claim 11, 12 "the combination of prior art does not teach the text input field in claim 11", Examiner disagrees, Becker taught the GUI for instant messaging with a display history, Becker disclosed a text pad for entering text into the chat system. The image pad is equivalent to the ink data in the applicant's invention. Further more, the method of Sun disclosed using handwriting or ink data that are well known in the art and incorporated into the chat system, Therefore the handwriting input area must be existed for the user to enter the handwriting in the chat system.

As regarding Applicant's third argument, "the history panel in the prior art cited only disclosed keeping the partial history that filled up to its display window". This is not true, the history panel 120 of figure 1 in Becker's disclosure shows the history of messages between clients. The GUI shows history of messages of instant messaging clients.

As regarding Applicant's fourth argument on claims 13-17, "the prior art preferences only display the URL in the status bar as regular HTTP request browser page, the present invention make use of hyperlink and back links techniques". Examiner disagrees, In Lloyd's disclosure, using hyperlink to represent the image object (see Lloyd col.12, lines 48-53).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Duyen Doan
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A handwritten signature in black ink, appearing to read "Wm. C. Vaughn, Jr.", with a stylized flourish at the end.

**WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER**